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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/807,697 | 04/17/2001 | Sylvain Chevreau | PF980072 | 2501 |

24498 7590 10/22/2004

THOMSON MULTIMEDIA LICENSING INC
JOSEPH S TRIPOLI
PO BOX 5312
2 INDEPENDENCE WAY
PRINCETON, NJ 08543-5312

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| EXAMINER |
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BAYAT, BRADLEY B

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,697

Applicant(s)

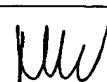
CHEVREAU ET AL.

Examiner

Bradley Bayat

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims 1-12 and the specification have been amended in the response filed on 25 June 2004; claims 1-12 remain pending. Amendments to the claims have not been addressed in the instant action, because applicant's declaration under 37 CFR 1.131 has failed to overcome the rejection.

Response to Amendment

The declaration filed on 25 June 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the rejection under 35 U.S.C. 102(e), as being anticipated by the Söhne et al. (hereinafter Söhne), U.S. Patent 6,397,333 B1 reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Söhne reference. Applicant has submitted a disclosure document in French without a translation and further lacking continuity of diligence leading up to the filing date of applicant's claimed invention.

Therefore, this action is made **FINAL**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Söhne et al. (hereinafter Söhne), U.S. Patent 6,397,333 B1.

As per the following claims, Söhne discloses:

As per claim 1, Söhne discloses a method of copying which avoids the bit-by-bit duplication of digital data arising from a source of digital data on a medium, wherein said method comprises a step of formatting the digital data arising from said source of digital data as a function of a serial number contained in said medium and a step of writing said formatted data onto said medium (column 2, lines 25-57).

As per claim 2, Söhne discloses the method as claimed in claim 1, wherein the serial number is recorded in an unfalsifiable manner on the medium during its manufacture (column 2, lines 58-62).

As per claim 3, Söhne discloses the method as claimed in claim 1, wherein the serial number is a unique number for each medium or exhibits a low probability of being common to two media (column 4, lines 50-51).

As per claim 4, Söhne discloses the method as claimed in claim 1, wherein the step of formatting of the digital data to be duplicated is carried out using a secret-key encryption algorithm such as DES or a public-key algorithm such as RSA (figures 1, 2 and associated text; column 2, lines 63-67).

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As per claim 5, Söhne discloses the method as claimed in claim 4, wherein the encryption key is dependent on the serial number (figure 1 and associated text).

As per claim 6, Söhne discloses the method as claimed in claim 5, wherein the encryption key is furthermore dependent on a secret parameter contained in any reading device adapted for reading the digital data arising from said source (figure 1 and associated text).

As per claim 7, Söhne discloses a method of copying which avoids the bit-by-bit duplication of digital data read by a reading device and copied onto a medium, wherein the medium comprises a serial number and in the method of coping comprises the following steps:

- sending of the serial number recorded on the medium to the reading device (column 2, lines 25-57),
- formatting of the digital data read with the aid of the serial number (column 2, lines 25-57), and
- recording on said medium of the formatted digital data (column 2, lines 25-57).

As per claim 8, Söhne discloses the method as claimed in claim 7, wherein the formatting step is carried out in the reading device (figure 1 and associated text).

As per claim 9, Söhne discloses the method as claimed in claim 7, wherein the reading device comprises means making it possible to read the medium containing the formatted digital data (column 2, lines 54-57).

As per claim 10, Söhne discloses the method as claimed in claim 7, wherein before performing the duplication of the digital data, it comprises a step of checking authorization to copy (column 3, lines 23-30).

As per claim 11, Söhne discloses a reading device allowing the implementation of a method of copying according to claim 1, wherein it comprises a formatting circuit adapted for receiving the serial number of the medium onto which the digital data are to be copied and providing as output, formatted data which are dependent on said serial number and are intended to be copied onto said medium (figure 1 and associated text).

As per claim 12, Söhne discloses a recording medium for digital data comprising a serial number which is unique or exhibits a low probability of being common with that of another medium, wherein it furthermore comprises recorded digital data, said digital data being formatted as a function of said serial number and of a secret parameter (figures 1 and 2 and associated text).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

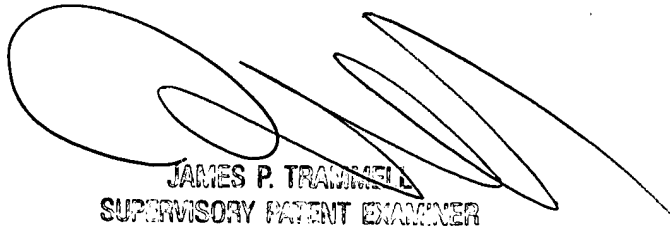
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNICAL BY CH 111 0100